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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,520	12/21/2004	Matti Myyry	P1545US00	8108
36671 7590 11/23/2009 DITTHAVONG MORI & STEINER, P.C. 918 Prince Street Alexandria, VA 22314				
EXAMINER LU, ZHIYU				
ART UNIT 2618		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com

Office Action Summary

Application No.

10/518,520

Applicant(s)

MYRY ET AL.

Examiner

ZHIYU LU

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-54 and 61-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-54 and 61-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 08/21/2009 have been fully considered but they are not persuasive.

Regarding 112 1st paragraph rejection, applicants argued that "establishing the group communication in the second communication network" is fully supported by at least the originally filed claims 1 through 30, and paragraphs (abstract, 0008, 0023-0024 & 0031) of the corresponding published application.

However, the Examiner does not agree. The limitation of "establishing the group communication in the second communication network" is not supported by the originally filed claims 1-30, at least not in the same context. Moreover, the original claims were rejected under Callaway, Jr. et al. Regarding the cited paragraphs of the corresponding published application, only the abstract supports the method of requesting group establishment via network 1 (N1, short-range), sending information on created group to network 2 (N2, e.g. GSM), and initiating group communication in N2. Nevertheless, none of the filed specification (including cited paragraphs 0008, 0023-0024 & 0031) and drawings supports initiating group communication in N2. The filed specification and drawings are about requesting group establishment via N1 and sending **created** group information to N2 as alternative storage. Even "... e.g. to the second network for establishing said group..." in paragraph 0031 does not clearly indicate that there is group communication in N2. And "said group" may just point to the created group in N1 because all the group communication are within N1 and only UEA sends/communicates information to N2 (as shown in filed drawings). So, for having such unclear and contradicting

evidences, where most of the evidences (the whole filed specification and drawings, except abstract) point to establishing group communication N1 and sending established group information to N2 for storage, the Examiner considers the argued limitation is lack of support in the filed application.

Thus, the rejection is proper and maintained.

Regarding the 102 rejections, by raising support above applicants argued the Kotzin does not teach the limitation rejected by 112 1st paragraph.

However, the Examiner does not agree. As explained above, the Examiner does not think the filed specification has sufficient support for the argued limitation. However, the Examiner takes the argued limitation into consideration in the following rejections. Yet, Kotzin still anticipates the limitation because of the broad limitation.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 31-32, 51-52 and 62-64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claim 64, there is no support in filed specification for “a computer program” and “a computer readable medium”.

In claims 31-32, 51-52 and 62-64, applicants claim “establishing the group communication in the second communication network”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 31-43 and 45-54, 61-73 and 76-77 are rejected under 35 U.S.C. 102(e) as being anticipated by Kotzin (US Patent#7002942, same as US2003/0026221).

Regarding claim 52, Kotzin anticipates an apparatus (106A of Figs. 1, 4, 7) comprising:

means (LAN TRANSCEIVER in 106A of Fig. 1) for sending a request (i.e. inquiry and/or page in Bluetooth protocol) for group establishment to at least one slave user equipment (106B-N of Figs. 1, 4, 7) over a first communications network (102 of Fig. 1) (Bluetooth inquiry for piconet establishment, 500A-506D of Fig. 5, or query messages in column 8 lines 61-67);

means (LAN TRANSCEIVER in 106A of Fig. 1) for receiving from at least one slave user equipment over the first communications network a response comprising information on a user for group establishment (500A-506D of Fig. 5, column 8 line 67 to column 9 line 11);

means (112 of Fig. 1) for creating the group based on the information received in responses from the at least one slave user equipment (column 8 lines 9-11);

means (LAN TRANSCEIVER in 106A of Fig. 1) for sending the information on the created group to all members of the group via the first communications network (column 6 lines 19-29, where broadcasting makes known of group members to all members of the group); and

means for establishing the group communication in the second communication network (508, 512A-D of Fig. 4, where communications in network 104 are for the created group in relaying data, which is considered as group communication in the second communication network; furthermore, group communication does not necessarily limit communication among each other).

Regarding claim 31, Kotzin anticipates a method as explained in response to claim 52 above, wherein the master device sends and stores group information in the second communication network (114 of Fig. 1, 604 of Fig. 6, column 9 lines 39-41).

Regarding claim 32, Kotzin anticipates a method of establishing a communications group in a communications network as explained in response to claim 52 above.

Regarding claim 51, Kotzin anticipates a user equipment comprising a group communications capability as explained in response to claim 52 above, where master device sends and stores group information in the second communication network (114 of Fig. 1, 604 of Fig. 6, column 9 lines 39-41).

Regarding claim 62, Kotzin anticipates an apparatus as explained in response to claim 51 above.

Regarding claim 63, Kotzin anticipates an apparatus as explained in response to claim 52 above.

Regarding claim 64, Kotzin anticipates a computer program embodied on a computer readable medium for controlling a computer to perform a method as explained in response to claim 31 above.

Regarding claims 33 and 65, Kotzin anticipates the limitations of claims 31 and 64.

Kotzin anticipates wherein at least one of the request or the response is a multicast request, a point-to-point request, a short message request, an instant message request, an e-mail message request, a multimedia message request, a unified messaging message request, a WAP (Wireless Application Protocol) message request, or an SIP (Session Initiation Protocol) message request (column 8 line 63).

Regarding claim 34, Kotzin anticipates the limitation of claim 31.

Kotzin anticipates further comprising, in creating or modifying the group, checking, by the master user equipment, the response from slave user equipment and if the information of the slave user equipment is acceptable, adding the slave user equipment to the group (inherent in Bluetooth grouping).

Regarding claim 35, Kotzin anticipates the limitation of claim 31.

Kotzin anticipates wherein the request comprises a file which guides the user of the slave user equipment to send only the information needed to establish the group to the master user equipment (inherent in Bluetooth connection setup).

Regarding claim 36, Kotzin anticipates the limitation of claim 31.

Kotzin anticipates wherein the request comprises a file which guides the slave user equipment to send only the information needed to establish the group to the master user equipment (inherent in Bluetooth connection setup).

Regarding claim 37, Kotzin anticipates the limitation of claim 31.

Kotzin anticipates further comprising retrieving, by the master user equipment, a file for the request from at least one of the first communications network, and the second communication network, from its memory (inherent broadcasting synchronization request), or from the slave user equipment.

Regarding claim 38, Kotzin anticipates the limitation of claim 31.

Kotzin anticipates further comprising retrieving, by the master user equipment, a file for the request (inherent broadcasting synchronization request).

Regarding claims 39, 53-54, 66 and 76, Kotzin anticipates the limitations of claims 31, 51, 64 and 62.

Kotzin anticipates wherein the first communications medium is a circuit switched network, a packet switched network, a wireless local area network, an IrDA network, a Bluetooth medium or a network according to the IEEE 802.11 standards (102 of Fig. 1).

Regarding claims 40, 67 and 77, Kotzin anticipates the limitation of claims 31, 64 and 62.

Kotzin anticipates wherein the second communications network a digital mobile communications network, a circuit switched network, or a packet switched network (104 of Fig. 1).

Regarding claim 41, Kotzin anticipates the limitation of claim 31.

Kotzin anticipates further comprising before sending the request from the master user equipment to at least one slave user equipment, selecting by the master user equipment an identification to be used in the information interchange (inherent in Bluetooth connection setup, eg. master device's identification and/or password).

Regarding claims 42 and 68, Kotzin anticipates the limitations of claims 31 and 64.

Kotzin anticipates further comprising sending the request is by using multicasting (column 6 lines 19-22).

Regarding claims 43 and 69, Kotzin anticipates the limitations of claims 31 and 64.

Kotzin anticipates further comprising sending the request by using broadcasting (column 6 lines 19-22).

Regarding claims 45 and 70, Kotzin anticipates the limitations of claims 31 and 64.

Kotzin anticipates further comprising sending by the master user equipment, the request automatically when new user equipment enters a predetermined area (inherent in Bluetooth device detection).

Regarding claim 46, Kotzin anticipates the limitation of claim 45.

Kotzin anticipates further comprising detecting entrance of a client or new user equipment into the predetermined area; and sending the request over the first communications network at least in the proximity of the entrance point (inherent in Bluetooth device detection).

Regarding claims 47 and 71, Kotzin anticipates the limitations of claims 45 and 70.

Kotzin anticipates further comprising sending the request periodically over the first communications network at least in the proximity of the entrance point to the predetermined area (inherent in Bluetooth device detection).

Regarding claims 48 and 72, Kotzin anticipates the limitations of claims 31 and 64.

Kotzin anticipates further comprising deleting by the master user equipment, user equipment from a group when user equipment exits a predetermined area or after a predetermined period of time has elapsed (inherent in piconet update).

Regarding claim 49, Kotzin anticipates the limitation of claim 48.

Kotzin anticipates further comprising detecting exit of a client or user equipment from the predetermined area, sending an identification request over the first communications network at least in the proximity of the exit point; and deleting a group member from the group on the basis of a response to the identification request, if any (inherent in piconet connection).

Regarding claims 50 and 73, Kotzin anticipates the limitations of claims 31 and 64.

Kotzin anticipates further comprising sending, by the master user equipment or another device provided with the group information, advertisements to the group members over the communications network (inherent in query).

Regarding claim 61, Kotzin anticipates the limitation of claim 31.

Kotzin anticipates further comprising modifying the group based on the information received in responses from the at least one slave user equipment (inherent in detecting new Bluetooth unit); and sending by the master user equipment information on the modified group to the second communications network (114 of Fig. 1, 604 of Fig. 6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kotzin (US Patent#7002942) in view of Jamieson et al. (US2002/0034959).

Regarding claim 44, Kotzin teaches the limitation of claim 31.

But, Kotzin do not expressly disclose the identification is an MSISDN number.

Jamieson et al. teach using MSISDN number as identification in talk group (paragraph 0022).

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate using MSISDN number as identification in talk group taught by Jamieson et al. into the method of Kotzin, in order to configured talk group with mobile telephones.

5. Claims 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotzin (US Patent#7002942) in view of Randall et al. (US Patent#7248677).

Regarding claims 74-75, Kotzin teaches the limitations of claims 31 and 62.

But, Kotzin does not expressly disclose wherein the group management server is for one of presence and instant messaging.

Randall et al. teach that a presence and instant messaging server holds information on individuals, groups, and organizations (column 19 lines 25-41, column 20 line 59 to column 21 line 40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate having network database server handling presence and instant messaging taught by Randall et al. into the method and apparatus of Kotzin, in order operate services for presence and instant messaging.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZHIYU LU whose telephone number is (571)272-2837. The examiner can normally be reached on Weekdays: 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Zhiyu Lu
Examiner
Art Unit 2618

/Zhiyu Lu/
Examiner, Art Unit 2618
November 18, 2009